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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 10/614,447 | 07/07/2003 | Juan Luis Morales | Honey Gold Pineapple | 7552 |
| 7590 | 06/16/2004 | | EXAMINER | |
| John Dodds 1707 N Street NW Washington, DC 20036 | | | HWU, JUNE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1661 | |
| DATE MAILED: 06/16/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/614,447 | Applicant(s) MORALES ET AL. | |
| | Examiner June Hwu | Art Unit 1661 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Drawings

The drawings are objected under 37 CFR 1.84 (u) (1), as numbering of the views must be preceded by the abbreviation "FIG." and should correspond with the description in the specification on page 2. See MPEP 1606. Replacement photographs in duplicates are required.

Comment

It is noted that the instant cultivar Honey Gold has the same cultivar name cited in The New Royal Horticultural Society Dictionary of Gardening on page 159, column 2, under *Ananas comosus*. The reference describes *Ananas comosus* 'Honey Gold' as a large fruit pineapple. It is uncertain if the instant cultivar and the reference cited are the same plant because the reference does not described a detailed description of 'Honey Gold'.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

More specifically:

A. Section 1612 of the Manual of Patent Examining Procedure states that there is a requirement that "the proposed variety name not be identical with or confusingly similar to other names utilized in the United States or other UPOV member countries for the same or a closely

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related species." The proposed cultivar name must also be consistent with the requirements set forth in the International Code of Nomenclature for Cultivated Plants -1980.

The attached reference from The Royal Horticultural Society Dictionary of Gardening discloses an *Ananas comosus* cultivar named 'Honey Gold'.

As 'Honey Gold', has been previously used as a cultivar name designation for a pineapple plant, it is necessary for applicants to take corrective action relative to the cultivar name of the "instant" plant such as by correcting same, as reuse of the cultivar name 'Honey Gold' is inadmissible under at least Article 48, Article 50 and Article 51 of the International Code of Nomenclature for Cultivated Plants - 1980.

Article 48 states (in part) that re-use of a previously utilized cultivar name may be permitted by the registration authority (in this case USPTO) "only if the registration authority is satisfied that the original cultivar is no longer in cultivation, has ceased to exist as breeding material or in a gene or seed bank, and is not an important component in the pedigree of other cultivars."

Article 50 states (in part): "Not more than one cultivar may have the same name within the same cultivar class." A cultivar class is set by the registration authority and is defined as "one or more genera, species, subspecies or cultivar groups."

Article 51 states (in part): "When confusion is caused by the use of the same name for two or more widely grown cultivars in the same cultivar class (see Art. 50), the cultivar for which it is the legitimate name is the one selected by a registration authority, or failing this, the cultivar first chosen and published as legitimately bearing the name..."

As plant names are associated with and used to identify particular plants and are therefore descriptive, for a United States Plant Patent to properly issue, the cultivar name set forth in the specification must be acceptable. Applicants must substantively address and obviate

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this issue responsive to this Office Action, so as to provide as complete a description of the plant as is reasonably possible.

B. Applicants should refer to cultivar names within single quotation marks, as this is the convention employed by the International Code of Botanical Nomenclature.

C. Page 1, lines 10-13, the recitation regarding the origin of the instant cultivar is unclear. Applicants describe the derivation of the claimed plant from clonal propagation. It is uncertain if somaclonal variation occurred or if another breeding technique was employed. Applicants should clearly state how the instant plant was bred.

D. Applicants are requested to recite whether the parent cultivar 'Tainung 11' has been patented in the United States, is currently the subject of pending U.S. plant patent application, or are non-patented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the appropriate cultivar name. If the cultivar is subject of a pending application, such should be referred to by serial number. If non-patented, --(non-patented)-- should be inserted after the appropriate cultivar name.

E. The specification does not "particularly point out where the variety of plant has been asexually reproduced". Correction is required.

F. Age of the observed plant should be disclosed in the specification. Correction is required.

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G. Applicants must set forth in the specification a brief description how the new variety is distinguished from related known cultivars.

H. Page 2, line 23, the recitation "Shows a mature plant, with three or less slips" does not correspond with the attached photograph of "Number 5 'Honey Gold' Pineapple Fruit". Number 5 appears to show a side view of a single pineapple fruit.

I. Page 3, line 23, the genus and species should be italicized. Correction is necessary.

J. Applicants should set forth in the specification a brief description of photograph "Number 6". In addition, it is unclear if "MA-2" is the breeder's reference number of the instant cultivar or if it is another variety of pineapple. Clarification and corrections are necessary.

K. Page 4, line 10, the recitation "5 y 7.4" is unclear relative to the diameter of the stem. Clarification and correction are necessary.

L. Applicants should set forth in the specification the color designation of the stem with reference from the employed color chart.

M. Applicants should set forth in the specification floral bract's size, margin type and color designation with reference to the employed color chart.

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N. Page 6, line 10, the recitation “reddish green” is vague regarding the color designation of the terminal crown leaves. Applicants should set forth in the specification the color designation with reference to the employed color chart of the terminal crown leaves.

O. Applicants should set forth in the specification the terminal crown leaves average size, number and margin type.

P. Page 6, line 14, the recitation “light lilac” is vague regarding the color designation of the petals. Applicants should set forth in the specification the color designation with reference to the employed color chart of the petals.

Q. Applicants should set forth in the specification a botanical description of the sepals such as size, shape and color designation with reference to the employed color chart.

R. Applicants should set forth in the specification the fruit core’s diameter and color designation with reference to the employed color chart.

S. Applicants should set forth in the specification the average height and diameter of the fruit.

T. Page 7, line 29, the recitation “14/3%” is unclear regarding the Brix of the claimed plant. Clarification and correction are necessary.

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U. Page 7, line 30, the recitation "original population" is unclear relative to the comparison of the ascorbic acid levels. Clarification is necessary.

V. Page 8, lines 2-3, the recitation "These characteristics of the 'Honey Gold' plant have been stable and it is anticipated that they will be consistently expressed in future generations" is vague because it is uncertain whether the claimed plant is stable and reproduced true to type in successive generations of asexual reproduction. Clarification and correction are necessary.

W. If additional information is available relative to plant/fruit disease and pest resistance/susceptibility such should be set forth in the specification or if not observed state – none observed --.

X. The claim must be drawn to entire "plant". Applicants should insert the word – plant – after "*Ananas comosus*". Correction is required.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Claim Rejection

35 USC § 112, 1st and 2nd Paragraphs

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Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

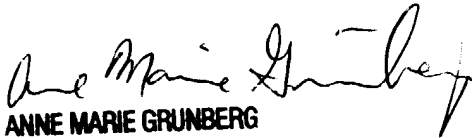
Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH


ANNE MARIE GRUNBERG
PRIMARY EXAMINER